

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 14-28 were in the application, claims 14-17 were previously withdrawn, and claim 18 has been amended. Withdrawn claims 14-17 were previously amended substantially to conform to amended claim 18, so as to be in condition for rejoinder, should claim 18 be considered allowable.

Claim 18 has been amended as clarify that the enclosures are arranged along the packaging line for enclosing work portions also arranged along the packaging line, with a pressurized environment enclosing one work portion, and an environment enclosing another work portion located upstream or downstream of said work portion requiring the pressurized environment. While this was implied, given the locations of the work portions as identified in the first paragraph of claim 18, it was thought that for clarity this should be stated more directly. No new matter is involved in this amendment, and as it relates solely to clarity.

Claims 18, 23, 24 and 27 were rejected as being anticipated by Minoshina, U.S. Patent no. 6,368,208.

"The term 'anticipation' in patent usage means that the invention was previously known to the public; that is, that it previously existed in the precise form in which it is claimed, including all of the limitations in the claim." SmithKline Beecham Corp. v. Apotex Corp., 439 F.3d 1312, 1324 (Fed. Cir. 2006) (Emphasis Added.)

"A claim cannot be 'anticipated' by prior art that does not have all of the limitations in the claim." Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346 (Fed. Cir. 2000) SmithKline Beecham Corp. v. Apotex Corp., 439 F.3d 1312, 1324 (Fed. Cir. 2006).

Minoshima does not anticipate the applicants' invention. Minoshima discloses a clean room environment which includes one chamber enclosed within another chamber, whereas the two enclosures of the applicants invention enclose work portions arranged one after the other along a packaging line so that one work portion is contained in a first enclosure and the second work portion is enclosed within a second chamber. Note that in

Minoshima, the equipment 2, loaders 5 and wafers are all located within the "clean room" inner chamber, and this receives re-circulated air.

As each and every element of claim 18 is not found in Minoshima, "in the precise form" as presented in claim 18, claim 18 and the claims depending therefrom are not anticipated thereby.

Claims 19-22, 25, 26 and 28 were rejected as being obvious over Minoshima in view of Monti.

In conducting an obviousness analysis, "[a] fact finder should be aware . . . of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 167 L. Ed. 2d 705 (2007). This is because the genius of invention is often a combination of known elements that in hindsight seems preordained. *In re Omeprazole Patent Litig.*, No. MDL 1291, 490 F. Supp. 2d 381, 2007 U.S. Dist. LEXIS 39670, at *400-01 (S.D.N.Y. May 31, 2007) (citation omitted) (quoting *KSR*, 127 S.Ct. at 1742); see also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985), *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 961 (Fed. Cir. 1983) (stating that "virtually every claimed invention is a combination of old elements").

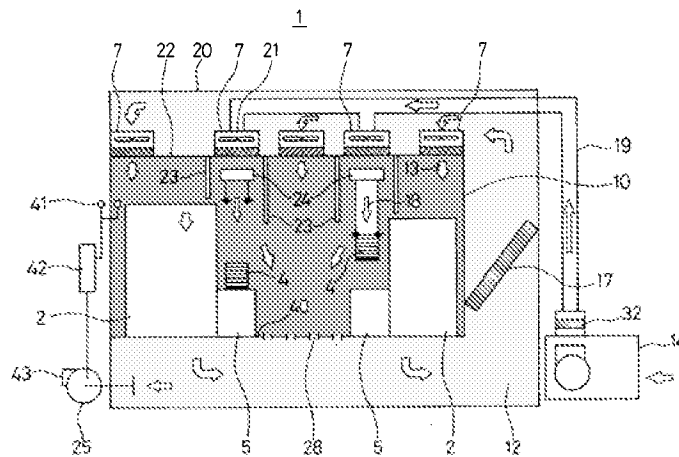
The Court in *KSR* also wrote, "[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 167 L. Ed. 2d 705 (2007) ("To facilitate review, this analysis should be made explicit.") (citing *Kahn*, 441 F.3d at 988... "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

The *KSR* decision has lead the U.S. Patent office to issue guidelines for applying the decision during the examination of claims to pending cases. The guidelines as well as the *KSR* decision itself both state the continued value of the teaching, suggestion or motivation test as relates to a finding of obviousness, as well as postulates a general question as to the predictability of the results achieved from a proposed combination, taken

from the view of one skilled in the art.

In this case, there is nothing which would teach, suggest or predictably lead one skilled in the art to the provision of the two enclosures with different pressure environments disposed around separate work portions arranged along a packaging line. Minoshima only discloses a clean room where an inner chamber (blue) is enclosed within a separate outer chamber (yellow), and the operation of these chambers provides a different function to the applicants' invention. That is, air from the outer chamber, as well as outside air are directly supplied to the inner chamber, with air leaving the inner chamber circulated for return to the inner chamber.

Fig. 2



Depending on the pressure differential relative to ambient, air is exhausted by the blower 25 from the outer chamber. Note that Minoshima requires a second dedicated supply of air to the inner chamber which is joined by the recirculating air from the outer chamber, both of which exit to the outer chamber.

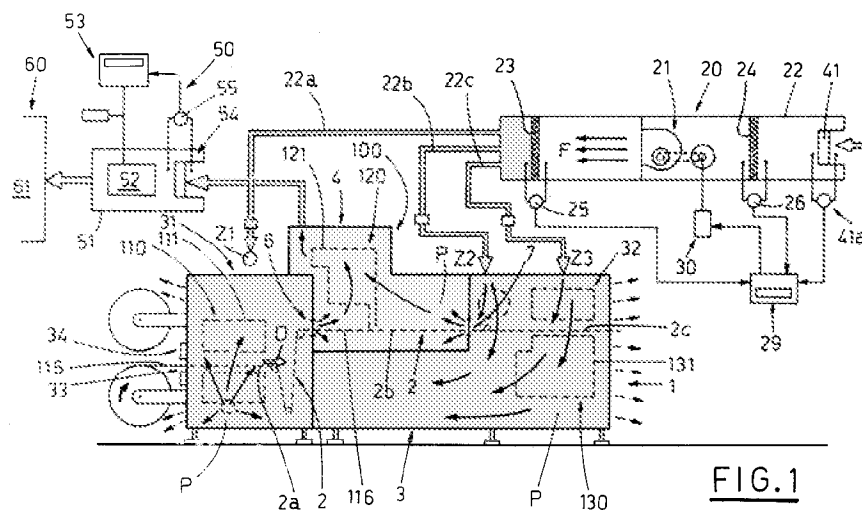
Note that if the exhaust means 25 are activated upon detection of a pressure difference between the air pressure inside the inner chamber 10 and the air pressure outside of the clean room (col. 5, l. 24-28), the exhaust means would operate to set the pressure in the inner chamber to a level greater than the outside pressure, to be sure that air always circulates from the inner chamber to the outer chamber. To maintain a clean room, the inner chamber must always be at a higher pressure than the outer chamber, and also the

pressure in the outer chamber must be above ambient, to provide ex-filtration rather than allow any infiltration. This is important as any unfiltered infiltration would be circulated to the inner chamber, carrying foreign material therewith. Only with higher pressures in both the inner and outer chambers can ex-filtration be assured.

The applicants' invention provides two chambers placed along a production line, each work station housed within its own chamber. Only one chamber is pressurized, that being the first chamber. The second enclosing chamber only receives air from the first chamber, the second enclosure being maintained at a pressure equal to the outer environment (atmospheric pressure). This despite pressurized air being delivered into the second enclosing chamber through the passages leading from the first chamber.

Under normal circumstances, the two chambers would reach an equilibrium pressure, that is, the second enclosing chamber pressure would rise to a level corresponding to the first chamber. However, the applicants' invention uses suction means for withdrawing air in an amount sufficient from an inside of the second chamber to keep the pressure substantially constant and equal to the atmospheric pressure, and to maintain the pressures in each chamber, as claimed, during operation of the packaging machine.

With reference to the applicants' invention, there are no air flows directed into the second chamber; air is only received from the first chamber:



As is clear, no re-circulated air is used in the applicants invention, nor is it permitted by the language of claim 18

Monti only discloses a packaging machine, and there is nothing to teach or suggest use of the inner/outer clean room type environment of Minoshima. Moreover, Minoshima totally encloses the equipment entirely within the inner chamber. No equipment is located outside of the inner chamber, and one skilled in the art, even combining these two patents would not be led to the system of the present invention.

In fact, combining the teaching of Monti and the teaching of Minoshima, a person of ordinary skill would not be led to the claimed invention, but in fact be led away from the invention, to enclosing an entire packaging machine within a clean room environment.

If the prior art teaches away from combining known elements in the manner claimed by the invention at issue, discovering a successful way to combine them is less likely to be obvious. See KSR Int'l, 127 S. Ct. at 1740, 1745. Consequently, the determination of obviousness is incorrect, and claims 19-22, 25, 26 and 28 are patentable.

Should claim 18 be in condition for allowance, rejoinder of claims 14-17 is hereby requested, as claim 14 substantially tracks the changes of amended claim 18.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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